

REMARKS/ARGUMENTS

I. PRIOR ART MATTERS

- A. The Office Action rejected claims 1 and 3-18 under 35 USC 103(a) as being unpatentable over Musacchia. Applicant respectfully traverses the rejection.

Specifically, the Office Action states:

Musacchia discloses the claimed invention except for the game call device constructed as one piece as recited in claims 1, 10, 14, and 17. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the game call device as one piece, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art.

Applicant respectfully disagrees.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.<sup>1</sup> If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness.<sup>2</sup>

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable

<sup>1</sup>MPEP Sec. 2142.

<sup>2</sup> Id.

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expectation of success must both be found in the prior art, and not based on applicant's disclosure.<sup>3</sup>

The fact that a prior art device could be modified to produce the claimed invention is not a basis for an obviousness rejection unless the prior art suggested the desirability of such a modification.<sup>4</sup> Both the suggestion and the expectation of the success must be founded in the prior art, not in the applicant's disclosure.<sup>5</sup> When obviousness is based on a single reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference.<sup>6</sup>

There is no suggestion to combine if a reference teaches away from its combination with another source. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be led in a direction divergent from the path that was taken by the applicant.<sup>7</sup>

Applicant respectfully traverses the § 103 rejection because the office action has not established a *prima facie* case of obviousness.

Musacchia does not disclose a suggestion or motivation within the four corners of the reference to make the combination. Furthermore, Musacchia teaches away from such a combination because the device of Musacchia is expressly disclosed as being constructed without an integrated game call so as to allow various types of game calls to be disposed so that maximum resonance is achieved. Abstract, Field of the Invention, Summary of the Invention. One of ordinary skill in the art, having Musacchia before him, would not be motivated to combine a game call with an adapter as one-piece because Musacchia teaches away from this.

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<sup>3</sup>Id. (emphasis supplied)

<sup>4</sup> *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984)

<sup>5</sup> *In re Dow Chemical Co.*, 837 F.2d 469 (Fed. Cir. 1988)

<sup>6</sup> *In re Kotzab*, 208 F.3d 1352 (Fed. Cir. 2000)

<sup>7</sup> *Tec Air v. Denso Mfg. Michigan, Inc.*, 192 F.3d 1353 (Fed. Cir. 1999)

Applicant pointed out the advantages of Applicant's invention over Musacchia in the Specification at page 3.

The reference does not teach or suggest all the claim limitations.

The claims are therefore allowable.

For the above reasons, Applicant respectfully requests the allowance of all claims and the issuance of a Notice of Allowance.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned Version With Markings to Show Changes Made.

Respectfully submitted,

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